

Remarks

1. Summary of Office Action

In the office action mailed May 6, 2005, the Examiner rejected claims 1-10, 17-19, 21-29, and 31-40 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,447,150 (Maggenti), and the Examiner rejected claims 11-16, 20, 30, and 41 under 35 U.S.C. § 103(a) as being obvious over a combination of Maggenti and U.S. patent No. 6,771,639 (Holden).

2. Status of the Claims

Applicant has amended claim 3 to correct a minor typographical error. Presently pending are claims 1-41, of which claims 1, 3, 12, 17, 26, and 36 are independent.

3. Response to § 102 Rejections Over Maggenti

The Examiner rejected claims 1-10, 17-19, 21-29 and 31-40 as being anticipated by Maggenti. Under M.P.E.P. § 2131, a prior art reference anticipates a claim only if the prior art reference discloses (expressly or inherently) each and every element of the claim. Applicant submits that the Examiner's rejection of claims 1-10, 17-19, 21-29 and 31-40 is improper, because Maggenti does not disclose all of the elements of any of these claims. With all due respect, the various sections of Maggenti cited by the Examiner in the office action do not disclose Applicant's claimed invention; further, no other portion of Maggenti discloses Applicant's claimed invention either. Consequently, Maggenti does not anticipate Applicant's claimed invention.

For the Examiner's convenience, the following subsections explain the deficiency of Maggenti in more detail.

a. Claims 1-2

Of these claims, claim 1 is independent. Claim 1 recites a method that involves (a) receiving into a network entity a signaling message indicative of a network communication, (b) the network entity *responsively* extracting from a data store a set of data usable by an application server to carry out a communication service in response to the signaling message, and (c) the network entity (i) outputting *the signaling message* for transmission over a network to the application server and (ii) making the set of data available for use by the application server in carrying out the communication service in response to the signaling message.

Maggenti does not teach a network entity that carries out the set of functions recited by claim 1. Rather, at best, Maggenti teaches a communication device (CD) that generates a SIP INVITE containing session description information stored by the CD, and that sends the SIP INVITE to a communication manager, and Maggenti separately teaches a communication manager (CM) that receives the SIP INVITE from the CD, that generates a *response SIP message* (namely, a SIP 200 OK message) containing session description information stored by the CM, and that sends the response message to the CD. (See Maggenti, at column 12, lines 3-7; column 21, lines 4-9; column 12, lines 3-7). However, none of those teachings, or any other teaching in Maggenti, amounts to what claim 1 recites.

At a minimum, for instance, Maggenti does not teach a network entity receiving a signaling message, extracting data that can be used by an application server to carry out a communication service in response to the signaling message, and outputting the signaling message for transmission over a network to the application server. Further, Maggenti does not teach such a network entity making the extracted data available for use by the application server.

Because Maggenti does not disclose the invention as recited in claim 1, Maggenti does not anticipate claim 1. Claim 2 depends from claim 1 and incorporates all of the limitations of claim 1. Therefore, for at least the same reason, Maggenti fails to anticipate claim 2.

Applicant does not acquiesce in the Examiner's further statements regarding dependent claim 2, but Applicant submits that those statements are moot in view of the fact that Maggenti fails to teach the invention of independent claim 1.

b. Claims 3-10

Of these claims, claim 3 is independent. Claim 3, as amended, recites a method that involves (a) receiving an initiation message indicative of a request by an entity to engage in a communication, (b) responsively extracting from a first data store a set of data usable by an endpoint application to set up the communication session, and (c) outputting *the initiation message* for transmission to the endpoint application and making the set of data available for use by the endpoint application to set up the communication.

Maggenti does not teach a method that involves this set of functions. Rather, at best, Maggenti teaches that a CD may send a SIP INVITE message to a CM, and that the CM may generate and send to the CD a *response* SIP message that contains session description information stored by the CM. (See Maggenti, at column 17, lines 42-46; column 12, lines 3-7). However, none of those teachings, or any other teaching in Maggenti, amounts to what claim 3 recites.

At a minimum, for instance, Maggenti does not teach receiving a session initiation, responsively extracting data usable by an endpoint application to set up the session, and outputting *the initiation message* for transmission to the endpoint application and making the set of data available for use by the endpoint application.

In this regard, note that Maggenti's disclosure of a CM sending a response SIP message back to a CD does not amount to outputting *the initiation message* for transmission to the endpoint application, since the response message is not the received message and is not even another form of the received message (as a proxy might generate). The response message is an altogether different message, designed to *respond* to the received message.

Because Maggenti does not disclose the invention as recited in claim 3, Maggenti does not anticipate claim 3. Claims 4-10 depend from claim 3 and incorporate all of the limitations of claim 3. Therefore, for at least the same reason, Maggenti fails to anticipate claims 4-10.

Applicant does not acquiesce in the Examiner's further statements regarding the dependent claims, but Applicant submits that those statements are moot in view of the fact that Maggenti fails to teach the invention of independent claim 3.

c. Claims 17-19 and 21-25

Of these claims, claim 17 is independent. Claim 17 recites a system that includes (a) a processor, (b) data storage, (c) user-profile data stored in the data storage, (d) proxy-server logic stored in the data storage and executable by the processor to receive a session initiation message and to responsively output the session initiation message for transmission via a packet-switched network to an endpoint application, the session initiation message being indicative of a request to set up a communication involving a user, (e) data-management logic stored in the data storage and executable by the processor, in response to receipt of a session initiation message, (i) to extract from the user-profile data a set of data usable by the endpoint application to facilitate set-up of the communication and (ii) to make the set of data available for use by the endpoint application in responding to the session initiation message.

Maggenti does not teach a system that includes these functions. Rather, at best, Maggenti teaches that a CM maintains databases of user-profile information, and that a CM sends a *response* SIP message to a CD upon receipt of a SIP INVITE from the CD. (See Maggenti, at column 17, lines 8-11, and 14-26; column 12, lines 3-7). However, none of those teachings, or any other teaching in Maggenti, amounts to what claim 17 recites.

At a minimum, for instance, Maggenti does not teach the data-management logic element of claim 17. In particular, Maggenti does not teach a system that extracts data from a user-profile store in response to a session initiation message and makes that data available for use by an endpoint application to which the system sends the session initiation message that it receives. As explained above, the act of the CM sending to the CD a *response* SIP message that contains session description information cannot constitute the claimed function, because the CD is not the endpoint application to which the session initiation message is sent. Rather, the CD is only an endpoint to which a *response* SIP message (i.e., a SIP 200 OK message) is sent.

Because Maggenti does not disclose the invention as recited in claim 17, Maggenti does not anticipate claim 17. Claims 18-19 and 21-25 depend from claim 17 and incorporate all of the limitations of claim 17. Therefore, for at least the same reason, Maggenti fails to anticipate claims 18-19 and 21-25.

Applicant does not acquiesce in the Examiner's further statements regarding the dependent claims, but Applicant submits that those statements are moot in view of the fact that Maggenti fails to teach the invention of independent claim 17.

d. Claims 26-29 and 31-35

Of these claims, claim 26 is independent. Claim 26 recites an improvement in a networked platform of the type having proxy-server functionality to receive a session initiation

message and to forward the session initiation message to an application server, wherein the application server then performs a service in response to the session initiation message, the improvement comprising. The improvement as recited in the claim comprises data-management logic that is executable by the platform, in response to receipt of the session initiation message, (i) to extract from a profile store data usable by the application server to facilitate performance of the service and (ii) to make the data available for use by the application server to facilitate performance of the service.

Maggenti does not teach this improvement. Rather, at best, Maggenti teaches that a CM includes databases of user-profile information and may use that information as a basis to provide a communication service. (*See* Maggenti, at column 17, lines 8-11, and 14-26).

At a minimum, for instance, Maggenti does not teach any platform (i) receives a session initiation message and forwards the session initiation message along to an application server and (ii) that extracts from a profile store data usable by the application server to facilitate performance of a service in response to the session initiation message and makes the data available for use by the application server to facilitate performance of the service. Although Maggenti teaches the endpoint CM application server extracting data from a database to facilitate carrying out a communication service, the CM application server cannot constitute a platform that sends the session initiation message to the CM application server, since the CM application server would not send a message to itself. Consequently, the disclosure of Maggenti cannot amount to the invention as recited in claim 26.

Because Maggenti does not disclose the invention as recited in claim 26, Maggenti does not anticipate claim 26. Claims 27-29 and 31-35 depend from claim 26 and incorporate all of the

limitations of claim 26. Therefore, for at least the same reason, Maggenti fails to anticipate claims 27-29 and 31-35.

Applicant does not acquiesce in the Examiner's further statements regarding the dependent claims, but Applicant submits that those statements are moot in view of the fact that Maggenti fails to teach the invention of independent claim 26.

e. Claims 36-40

Of these claims, claim 36 is independent. Claim 36 recites a method that involves (i) receiving into a registration server a signaling message indicating that a user is online in a communication network, and (ii) the registration server responsively extracting from a data store a buddy-list designated for the user, and the registration server making the buddy-list available for use by an application server in setting up a communication for the user.

Maggenti does not teach a method that involves this set of functions. Rather, at best, Maggenti teaches that a CM receives a SIP INVITE from a CD and processes it to set up a PTT session, and Maggenti teaches that a CD has a list of nets and can update the list through communication with the CM. (*See* Maggenti, at column 21, lines 4-9; column 10, lines 33-40). Yet claim 36 recites a registration server carrying out the functions of receiving the message, extracting the data, and making the data available for use by the application server. It would be inconsistent and improper to conclude that the CM is the registration server for part of claim 36 (i.e., for purposes of receiving a message) but that the CD is the registration server for another part of claim 36 (i.e., for purposes of extracting data and making the data available for use by an application server).

Because Maggenti does not disclose the invention as recited in claim 36, Maggenti does not anticipate claim 36. Claims 37-40 depend from claim 36 and incorporate all of the

limitations of claim 36. Therefore, for at least the same reason, Maggenti fails to anticipate claims 37-40.

Applicant does not acquiesce in the Examiner's further statements regarding the dependent claims, but Applicant submits that those statements are moot in view of the fact that Maggenti fails to teach the invention of independent claim 36.

4. Response to § 103 Rejections Over Maggenti and Holden

The Examiner rejected claims 11-16, 20, 30, and 41 as being obvious over a combination of Maggenti and Holden. Under M.P.E.P. § 2143, in order to establish a *prima facie* case of obviousness of a patent claim over a combination of references, the Examiner must establish how the combination discloses or suggests all of the elements of the claim. Applicant submits that the Examiner's rejection of claims 11-16, 20, 30, and 41 is improper, because the combination of Maggenti and Holden does not disclose or suggest all of the elements of any of these claims.

Each of claims 11-16, 20, 30, and 41 depends ultimately from one of the independent claims discussed above. For the reasons discussed above, Maggenti fails to disclose the invention as recited in any of the independent claims. Further, Applicant submits that Holden fails to make up for the deficiency of Maggenti.

At best, Holden teaches that a user device can send a SIP INVITE that includes "cover data" defining an announcement, and that the recipient device can present that announcement to a called party so the called party can learn something more about the call than just the calling number. Yet the disclosure of Holden does not make up for the above discussed deficiency of Maggenti. Further, the Examiner has not pointed to any disclosure in Holden that makes up for that deficiency. Consequently, the Examiner has not established a *prima facie* case of

obviousness of claims 11-16, 20, 30, and 41.

5. Conclusion

In view of the foregoing, Applicant submits that all of the pending claims 1-41 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and notice to that effect.

Note Regarding Information Disclosure Statement

Applicant thanks the Examiner for considering the art cited in the information disclosure statement filed November 7, 2003. Applicant notes, however, that the Examiner did not initial reference number 29 (International Search Report from International Application No. PCT/US02/31411, dated 4 March 2003) on the Form PTO-1449. To complete the record for this case, Applicant respectfully requests the Examiner to initial that reference on the form and to mail a new copy of the form.

Respectfully submitted,

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